

Appl. No.: 09/913,378
Response dated October 7, 2005
Response to Decision on Appeal of August 10, 2005

Remarks:

Claims 10-23 are pending in the present application. Claims 24-27 are added and call for the specified polyol component of the compound in (b)(1). Basis for claims 24-27 is provided at Page 3, lines 27-28 through Page 4, lines 1-16.

This Reply accompanies a Request for Continued Examination following the Decision on Appeal ("the Decision") from the Office's Final Rejection of claims 10-23.

The Decision reversed the Office's rejection of the claims under 35 USC §102(e) as anticipated by U.S. Pat. No. 6,207,014 ("de Haut"). However, the Decision affirmed the rejection of the claims under 35 USC §103(a) over de Haut.

This Reply should not be construed in any manner whatsoever as an acquiescence with the Decision's finding with respect to the rejection under §103. Applicants note that the Board's reasoning at page 5, 1st full paragraph, of the Decision for affirming the Office's rejection of the claims under Section 103 is totally conclusory in nature and merely recites standard case law citations without specifically applying the law to the facts at issue. Applicants specifically reserve their legal rights to traverse and challenge the Board's findings in this regard for another day, as they may deem appropriate.

The Decision also found that Applicants' arguments of unexpected results in the specification at pages 25 and 26 were lacking on the basis that the data presented therein was "not commensurate in scope with the degree of protection sought by the claimed subject matter."

According to the Decision at page 7, "the data presented in the specification is limited to testing on a specific paper substrate impregnated with five specific emulsions.

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These emulsions all use the same polyglycerol-2-dipolyhydroxystearate... Appellants must also explain why the showing is commensurate in scope with the claimed subject matter...Appellants have not directed us to evidence that establishes why the relatively few examples presented in the specification would have been representative of the scope of the claimed invention."

Applicants note for the record that the Board's legal reasoning, that de Haut is a *prima facie* obvious reference and that Applicants' showing of surprising and unexpected results are insufficient based on too few examples, is analytically and legally inconsistent. The Board, on the one hand, finds that one of skill would have reasonably expected that the multitude of components for the emulsions disclosed in de Haut would have led one of skill to the claimed invention. Yet, on the other hand, the Board rejects Applicants' showing of unexpected results based on too few examples.

Nevertheless, Applicants have carried out further experimentation to address the Board's finding that the evidence is not commensurate in scope with the claimed invention, which is attached herewith as a Declaration under 37 CFR 1.132 by Dr. Rolf Kawa, one of the inventors.


These experimental results show that a polyethylene glycol as the polyol of the compound (b)(1) of the emulsion used in the process of claim 10 provided a paper substrate with a softness of +++ (very soft) and a sensory result of "wet."

It is respectfully submitted that this additional data demonstrates that the surprising results achieved by way of the present invention are commensurate in scope with the claimed invention, as Applicants have presented a showing of a 2nd polyol derivative within the scope of the claimed invention.

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In view of this Reply and the Rule 132 Declaration, favorable consideration of claims 10-27 is respectfully solicited.

Respectfully submitted,


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Enc.: Declaration under 37 CFR 1.132